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**UNITED STATES PATENT &  
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL  
PROPERTY AND DIRECTOR OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE  
Washington, D.C. 20231

#129

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In re application of	:	DECISION ON PETITION TO
Giok Djien Go	:	INVOKE THE SUPERVISORY
Application No. 08/860,182	:	AUTHORITY OF THE
Filed: June 22, 1997	:	COMMISSIONER UNDER
For: VEHICLE DOOR FOR CAR AND TRUCK:	:	37 CFR 1.181

This is in response to the letter dated June 2, 2000 regarding Application No. 08/860,182 and the Office action mailed April 10, 2000 in which Applicant objects to the "interference" by Examiner Jason Morrow and Supervisory Patent Examiner D. Glenn Dayoan and requests an investigation of the prosecution of this application. The delay in responding to this letter is regretted.

At the outset, it is noted that the letter was addressed to the Board of Patent Appeals and Interferences in order to "object to the interference by the above-mentioned examiners." However, as set forth below, the instant application is not in an interference or under appeal. Therefore, this matter has been referred to Technology Center 3600 for review.

Under 37 CFR 1.191 an applicant whose claims have been either twice rejected or finally rejected may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences. Since the claims of the instant application have been twice rejected, applicant could have chosen to file a notice of appeal. The June 2 letter gives no indication that applicant intended for it to be considered a Notice of Appeal. Furthermore, since this application is not involved in an interference as defined by 35 USC §135 which is conducted before the Board of Patent Appeals and Interferences, it is assumed that Applicant wishes to petition to invoke the supervisory authority of the Commissioner under 37 CFR 1.181 to review the *ex parte* action by the examiner.

**PROSECUTION HISTORY**

In order to fully understand how the prosecution of this application progressed, a prosecution history is provided below:

- October 14, 1998 a first Office action on the merits was mailed in which claims 1 and 2 were rejected under 35 USC §§102(e) and 112(2). Claims 3-34 were objected to as being presented in improper multiple dependent form. The specification and drawings were also objected to for various reasons.
- December 23, 1998 Applicant's response was received. This response included a substitute specification and amended claims 1-34.
- On February 10, 1999 the Examiner mailed a final rejection in which claims 1-34 were rejected under 35 USC §112(2) and claims 1, 2, 9-27, 33, and 34 were rejected under 35 USC §102(e). Claims 3-8 and 28-32 were indicated as being allowable if the §112(2) rejections were overcome and they were rewritten in independent form.
- June 23, 1999 Applicant filed a request for a Continued Prosecution Application (CPA). No preliminary amendment was submitted with the request for CPA.
- August 31, 1999 the Examiner mailed a final rejection which was virtually identical to the February 10, 1999 Office action. This was due to the fact that Applicant had not submitted an amendment or other type of response on the merits since the February 10 Office action.
- September 10, 1999 Applicant submitted a response to the final rejection of August 31 by facsimile transmission. This response only included claims 1-34. On September 15, 1999 Applicant submitted another substitute specification three sets of claims numbered 1-34 one of which appears to be a duplicate copy of the claims submitted by fax.
- On October 8, 1999 the Examiner mailed an advisory letter to Applicant informing him that it was mandatory that the disclosure be amended to make it more understandable to allow the Examiner to make a meaningful comparison of Applicant's invention with the prior art. **The Examiner set a one month shortened statutory period for response to this letter.**
- On November 10, 1999 Applicant submitted a response to the October 8 letter which included two copies of Figure 15, two substitute specifications and two separate sets of claims. One set of claims included claims 1-34 and the other set included claims 1-28. **It is noted that this response was not submitted within the time period set by the examiner and no extension of time was requested.**
- On April 10, 2000 the Examiner mailed yet another nonfinal Office action. Claims 1-34 were again rejected under 35 USC §112(2) for the same reasons set forth in the February 10 and August 31, 1999 actions. In addition, claims 1, 2, 26-28, and 31-34 were rejected under 35 USC §102(b) on a new reference and claims 3-25 and 28-32 were indicated as being allowable if the rejections under §112(2) were overcome.
- June 2, 2000 Applicant filed the petition under consideration. **No response to the April 10, 2000 has been submitted.**

## ANALYSIS OF ISSUES

Review of the application file history reveals that Applicant appears to be unfamiliar with procedural matters regarding prosecution of a patent application in the United States Patent and Trademark Office (USPTO). Specifically, it appears that early in the prosecution of the present application Applicant was unfamiliar with the proper procedures involved with amending the specification and/or claims so as to obviate the Examiner's objections and rejections.

Applicant claims that in September 1999 he twice submitted the amendments to the claims and abstract, addressing the objections raised in the first, second and third Office actions, dated October 14, 1998, February 10, 1999, and August 31, 1999, respectively. However, in response to the final rejection mailed August 31, 1999, the record shows that Applicant merely submitted a new set of claims 1-34 on September 10, 1999, a new specification and abstract on September 15, 1999 along with three sets of claims, without properly responding to each rejection and objection made as required by 37 CFR 1.111 (i.e., Applicant failed to include remarks which specifically addressed each and every rejection and objection made by the Examiner). It is noted that a substitute specification may be entered if Applicant satisfies the requirements of 37 CFR 1.125(b). 37 CFR 1.125(b) states that Applicant shall provide "a statement that the substitute specification includes no new matter" and "a marked up version of the substitute specification showing all the changes (including the matter being added to and the matter being deleted from) to the specification of record."

In any event, the Examiner gave Applicant another chance to put the application in condition for allowance by withdrawing the finality of the Office action dated August 31, 1999 in the Office action dated October 8, 1999. Furthermore, it was determined that the application was so replete with errors that more changes would be needed before the Examiner could issue another action on the merits.

Two responses to the Office action mailed October 8, 1999 were received on October 17, 1999 and November 7, 1999. Again, neither response satisfied the requirements of a proper response under 37 CFR 1.111. Nevertheless, the Examiner repeated the last outstanding Office action dated August 31, 1999 in order to give Applicant one further opportunity to submit a proper response which addressed every ground of objection and rejection. This most recent Office action was mailed on April 10, 2000.

The following is a specific response to each of the issues identified in Applicant's letter of June 2, 2000:

### Issues 1 and 9

The substitute specification filed September 15, 1999, including the drawings, were received but not entered as they failed to comply with 37 CFR 1.125(b). The claims

filed September 15, 1999, while not submitted in compliance with 37 CFR 1.121, have been entered.

## Issue 2

The Examiner requested a direct fax to informally discuss changes with Applicant which would obviate any objection and/or rejection. Since Applicant signed each paper submitted, each paper was properly treated as being an official response to each of the respective Office actions. It is suggested that in the future informal proposals be identified as such, e.g., "DRAFT", and remain unsigned.

## Issues 3-5

Applicant is again reminded that the examination process of an application filed in the USPTO differs from the examination process in either the European Patent Office or the British Patent Office.

## Issues 4-8

The Examiner has correctly applied patent examining procedures that are consistent with the policies of the USPTO in rejecting/objecting to Applicant's disclosure and claims.

## **DECISION**

Applicant has committed two critical errors during the prosecution of this application. First, Applicant did not take precautions to respond to the October 8, 1999 action within the shortened statutory period set by the examiner. The response of November 10, 1999 was two days late and Applicant neither requested nor paid for an extension of time. The application stood abandoned as of November 9, 1999 as a result. However it is apparent that the Examiner did not recognize that the application was abandoned since he mailed another nonfinal Office action on April 10, 2000 which, in essence, reinstated the application to pending status. Applicant neither responded to this Office action within the three month shortened statutory period for response provided for that purpose nor submitted a response along with a request for an extension of time. Since the six month statutory period for response to the April 10, 2000 action has expired, the application currently stands abandoned, 37 CFR 1.135.

Applicant may wish to consider filing a petition to revive under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay) as discussed below.

I. Unavoidable Delay

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; (2) the petition fee required by 37 CFR 1.17(l); and (3) an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the reply was unavoidable. This includes a satisfactory showing that the cause of the delay resulting in failure to reply in a timely fashion to the Office action was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) might be appropriate.

II. Unintentional Delay

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; (2) the petition fee required by 37 CFR 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The petition fee required by law for filing a petition under unavoidable standard is \$110. The fee for a petition under the unintentional standard is \$1,240. If applicant has, or can qualify as a "small entity" and does so prior to or together with the payment of the fee, the fee will be one-half of the amount indicated.

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive. The required items should be promptly submitted under a cover letter entitled "Petition to Revive."

Further correspondence with respect to a petition to revive should be addressed as follows:

By Mail: Deputy Commissioner of Patent Examination Policy  
Box DAC  
Washington, DC 20231

By Fax: (703) 308-6916  
Attn: Office of Petitions

By Hand: Crystal Plaza 4, Suite 3C23  
2201 South Clark Place  
Arlington, VA 22202

Telephone inquiries should be directed to the Office of Petitions Staff at (703) 305-9282.

### SUMMARY

The petition is **GRANTED** to the extent that the requested relief (i.e., an "investigation" of various occurrences during the prosecution) has been carried out. The entire prosecution history has been reviewed. This review has not revealed any arbitrary or capricious action on the part of the Examiner.

The application stands **ABANDONED** due to Applicant's failure to file a timely and proper response to Examiner's Office action of April 10, 2000.

This application will be forwarded to the Examiner of record for preparation of the Notice of Abandonment and then to the Files Repository.



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